

AF/2700

#17  
5-14-03  
TR

RECEIVED  
JUN 13 2002  
Technology Center 2600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 7833 )  
 )  
Group Art Unit: 2743 )  
 )  
Serial No.: 09/181,151 )  
 )  
Examiner: M. Ramakrishnaiah )  
 )  
Filing Date: October 28, 1998 )  
 )  
Title: Establishing Audio )  
Communication During )  
Initialization of Video )  
Conference Calls )

**CERTIFICATE OF MAILING**

I CERTIFY THAT THIS DOCUMENT IS ADDRESSED  
TO THE COMMISSIONER OF PATENTS AND  
TRADEMARKS, WASHINGTON, DC 20281, AND WILL  
BE DEPOSITED WITH THE U.S. POSTAL SERVICE,  
FIRST CLASS POSTAGE PREPAID, ON

MAY 28, 2002

GREGORY A. WELTE

**REPLY**

This is a Reply to the Examiner's Answer mailed on March 26, 2002. This Reply will (1) address the points made in Part 11 of the Examiner's Answer, which begins on Answer page 7, and (2) begin with explaining an apparent mistake in the interpretation of Dagdeviren.

First a Summary of Selected Points of this Reply will be given.

**Summary of Selected Points**

Point 1

The Answer asserts that Dagdeviren shows claim 2(b), which recites a POTS call. (POTS is industry jargon for Plain Old Telephone Service.) The answer asserts that the POTS call is shown at column 8, line 30.

However, that location refers to a call placed by a video

09/181,151  
Art Unit 2743  
7833

phone, such as video phone 107 in Dagdeviren's Figure 1. It cannot refer to a call placed by a POTS phone, because the context explains how a switchover is made from an audio call to an audio-video call. POTS phones cannot perform such switchovers. The location in question refers to a call placed by a video phone.

The video phone 107 communicates using **digital signals** on line 108. The video phone has no capability of communicating using analog signals, as required by a POTS call. (The video phone does perform analog-digital conversion, in its internal microphone and speaker, but that is not relevant. Also, if the video phone calls a POTS phone, the telephone company converts the digital call to an analog call.)

Dagdeviren describes the call in question at column 5, lines 55 - 60, and refers to it as occurring on a "logical" (ie, digital) channel. At that location, Dagdeviren states that the call uses the B (Bearer) channel of an ISDN connection. ISDN connections are digital.

Therefore, the passage in Dagdeviren does not show claim 2(b). The passage refers to a digital call, made by a digital device. That is not a POTS call.

#### Point 2

Appellant's Brief argued several times that certain rejections failed to comply with the CAFC's decision of In re Dembiczak.

09/181,151  
Art Unit 2743  
7833

Specifically, the Brief argued that no "objective evidence" "in the prior art" was given showing a teaching in favor of combining references.

In attempted rebuttal, the Answer, in effect, asserts that (1) certain references, objectively viewed, show certain claim elements, and (2) that qualifies as "objective evidence."

However, the Answer confuses

objective evidence of a **teaching for combining  
references**

with

objective evidence showing claim elements in  
the prior art.

Objective evidence of a **teaching** is required. Whether a reference actually shows the claimed elements is a different issue.

Further, the Answer apparently asserts that the presence of an element in a reference acts as a teaching for combining that element with another reference. On its face, this assertion is invalid.

### Point 3

The Answer combines two references under the following reasoning.

(1) Reference P shows an audio-only call with  
static images,

09/181,151  
Art Unit 2743  
7833

(2) Reference D teaches conversion of an audio-only call into an audio-video conference,

so therefore,

(3) The references are combinable: D teaches conversion of P's audio-only call to an audio-video conference.

The main problem is that P does not show an audio-only call. P shows an audio call, with static images displayed by an associated computer. Thus, D's teaching, which refers to audio-only calls, does not apply to P.

But even if P showed the same call as D, the reasoning is still invalid. D does not stand for the proposition that all calls similar to his should be converted in his manner. That is common sense.

Another problem is that the conversion to an audio-video call requires additional equipment to be added to P. That is a modification of P, contrary to MPEP § 2143.01, cited herein.

Further, that conversion eliminates P's static images, which defeats P's intended purpose, again contrary to MPEP sections cited herein.

Further still, D is based on the premise that people using video telephones may call people having ordinary telephones, but may not know the type of telephone being called. No such lack of

09/181,151  
Art Unit 2743  
7833

knowledge exists in P. All parties are known to possess the same equipment.

#### Point 4

The Brief pointed out that Morino is contrary to the claims. The Answer asserts that this contrariness can be ignored, because Morino is being cited for a specific element contained therein.

That procedure is not allowed. References are read as-a-whole. MPEP § 2141.03, cited herein, states that teachings in references which are contrary to the claims must be considered.

#### **End Summary**

#### **Interpretation of Dagdeviren**

A casual reading of Dagdeviren may give the impression that Dagdeviren shows claim 2. However, that is not so, because Dagdeviren does not actually show claim 2(b): no POTS (Plain Old Telephone Service) call is present. The Answer relies on Dagdeviren's "voice grade call" to show this POTS call. (Dagdeviren, column 8, line 30.) However, that call is not actually a POTS call. This will be explained.

Dagdeviren's Figure 1 shows POTS telephones, such as 101 and 105. They communicate with the CENTRAL OFFICE SWITCH 110 over analog (POTS) lines 102 and 106. (Column 4, lines 21 - 25.)

Figure 1 also shows ISDN compliant devices, such as video

09/181,151  
Art Unit 2743  
7833

phones 103 and 107. The video phones communicate with the CENTRAL OFFICE SWITCH 110 over "subscriber digital loops" such as 104 and 108. (Column 4, lines 25, 26, and 34.)

However, the video phones can only communicate using digital signals. Dagdeviren describes their operation, beginning at column 5, line 53. The video phones communicate digitally, and cannot communicate directly with the POTS telephones 101, which require analog communication.

When a video phone makes a call, the video phone does not necessarily "know" what type of telephone will answer the call, digital or POTS. (See column 1, lines 35 - 47.) Accordingly, the overall system has been designed so that the video phone expresses a preference for an audio-video call. However, if it is found that the receiving party is only equipped with a POTS telephone, then an audio-only conference is held. (Column 2, lines 4 - 15.)

Therefore, two cases should be distinguished:

CASE 1 (video-to-POTS). If video phone 107 in Dagdeviren's Figure 1 places a call to POTS telephone 105, the CENTRAL OFFICE SWITCH 110 receives digital signals on line 108. The CENTRAL OFFICE SWITCH 110 realizes the analog nature of the receiving POTS telephone 105, and so converts the digital signals on line 108 into analog signals usable by POTS

09/181,151  
Art Unit 2743  
7833

telephone 101, and transmits those analog signals on line 106.

CASE 2 (video-to-video). If video phone 107 calls video phone 103, the CENTRAL OFFICE SWITCH 110 realizes that two ISDN devices are involved, and sets up a clear digital channel between them.

Nevertheless, the video phone 107 can place a strictly audio call, without video. But such a call is still placed using an ISDN channel (the voice grade bearer B channel: column 5, line 59). If such a call occurs, and both parties later realize that they both are equipped with video phones, Dagdeviren's invention allows them to gracefully transition from such an audio-only call to a full audio-video call. (Column 2, bottom.)

Therefore, several things are clear so far:

-- IN ALL CASES, when a video phone in Dagdeviren places, or receives, a call, that call **IS NOT A POTS CALL**. It is digital, although it may be converted to analog form, at a POTS telephone.

-- If, in Dagdeviren, a video phone calls a POTS phone, there is no possibility of conversion to an audio-video call. This is common sense: POTS phones 101 and 105 cannot

09/181,151  
Art Unit 2743  
7833

handle audio-video calls.

-- Therefore, conversion **only** occurs (if at all) when a video phone calls another video phone. But, as just explained, the initial audio call is **DIGITAL**. It is **NOT** a POTS call. That call **MUST** be digital, because

- 1) the video phones have no provision for transmitting and receiving analog signals on lines such as 104 and 108, and
- 2) lines 104 and 108 are expressly stated to be digital. (Column 4, line 356.)

The Answer relies on Dagdeviren's "voice grade call" in column 8, line 30, to show the POTS call of claim 2(b).

That "voice grade call," again, is a **digital** call, made by one of Dagdeviren's video phones. It cannot be made by one of his POTS phones, because no conversion into an audio-video call is possible. The context of column 8, line 30, describes the conversion process. That does not apply to a POTS telephone.

Further, this call is described in column 5, lines 55 - 60. It is made on the B (bearer) channel of the ISDN line. ISDN lines are digital. Also, the call is **digital** because, if made by video phone 107, it is placed on **digital** line 108.



09/181,151  
Art Unit 2743  
7833

It is called "voice grade" because only a small bandwidth (ie, a small number of bits per second) is allocated to it, and that bandwidth is suitable for voice communication. For example, an ordinary POTS telephone has a bandwidth in the range of 3,000 Hz.

Therefore, the "voice grade call" of Dagdeviren's column 8, line 30, is a **digital call** made on the B channel of an ISDN line. If video phone 107 calls video phone 103, for example, digital signals are carried by digital lines 108 and 104. That is not a POTS call. That is a first point of confusion over Dagdeviren.

A second point of confusion is that Dagdeviren refers to "voice grade trunks" 111 and 118. (Column 4, line 54 et seq.) He states that ISDN traffic may be carried over those trunks. But that does not mean that a call from video phone 107 to video phone 127, over trunks 111 and 118, becomes a POTS call. The digital signals on line 108 are not converted to analog signals, in order to travel on the trunks 111 and 118.

In conclusion, Appellant points out the following:

- Dagdeviren's conversion from an audio call to an audio-video call **only** occurs when one video phone calls another.
- In such a case, the call placed is a low-bandwidth, voice-grade call. But it is **digital**, not POTS. It is carried on the B

09/181,151  
Art Unit 2743  
7833

(Bearer) channel of an ISDN channel, which is digital.

-- In such a case, both video phones transmit, and receive, digital signals.

-- Those digital signals travel on digital lines, such as 108.

-- That call **IS NOT** a POTS call, as in claim 2(b).

Appellant offers to submit an affidavit on the preceding points, if the Board so requests. No affidavit is herewith submitted, because the facts seem perfectly clear.

## **ANSWER, PART 11**

### **Section 1**

Section 1, Part 11, of the Answer asserts that Partridge provides a motivation for combining Partirdge and Dagdeviren. The supposed motivation is that Partridge "teaches using static image of a caller as an extension of caller ID function to screen calls."

This assertion has been addressed in the Brief, Summary of Argument regarding claim 1.

In addition, Appellant repeats that this "teaching" of Partridge is **contrary** to Dagdeviren. Dagdeviren is based on the assumption that a party receiving a call may not possess video capabilities. If you add Partridge's static image, you now defeat

09/181,151  
Art Unit 2743  
7833

Dagdeviren's assumption, and remove any need for Dagdeviren's system.

Contrary references cannot be combined.

## Section 2

The Answer asserts that Dagdeviren shows a POTS call in column 8, lines 27 et seq. This has been addressed above.

## Section 3

### Claims 11 - 13

The Answer's assertions were addressed in the Brief, pages 26 - 28.

Regarding the Answer's assertions at the top of page 9, Appellant respectfully submits that the Answer is mis-interpreting the Dembiczak decision. The question is not whether Morino provides objective evidence showing part of a claim. The question is whether Morino shows objective evidence of a **TEACHING** for combining references.

The presence of a claim element in Morino does not, by itself, act as a teaching for combining that element with something else.

### Claims 1, 3, 4, 7, and 9

The Answer's response to Appellant's Problems 1 through 9 is addressed by the Brief's discussion of those Problems. (Answer,

09/181,151  
Art Unit 2743  
7833

pages 10 - 14; Problems 1 - 9 are discussed in Brief, pages 13 - 21.)

Answer, Page 14, First Full Paragraph

Assuming arguendo that the Answer is correct, the Answer has only shown that Partridge shows claim 1(a) and (b).

Answer, Page 14, Second Full Paragraph

The Answer asserts that

- (1) Partridge shows an audio-only call with static images,
- (2) Dagdeviren teaches conversion of an audio-only call into an audio-video conference,
- so therefore,
- (3) The references are combinable.

Several problems exist in this logic.

One is that Dagdeviren does not teach conversion of Partridge's type of call into an audio-video conference. Restated, Partridge's system is not an audio-only call, but an audio-only call **with static images**. Premise (2), above, states that Dagdeviren teaches conversion of an audio-only call. That premise is not applicable to Partridge.

A second problem is that Dagdeviren's philosophy is not

09/181,151  
Art Unit 2743  
7833

applicable to Partridge. As explained in the Brief, Dagdeviren presumes that the receiving party may be equipped with an ordinary telephone, and nothing else. If it turns out that both parties are equipped with video phones, then Dagdeviren's system lets the parties convert into a video call.

However, that has no relevance to Partridge. None of Partridge's parties are equipped with ordinary telephones, and nothing else. All those parties have (1) a telephone plus (2) a computer which displays the static images.

If a party in Dagdeviren called a Partridge-party, no conversion could take place, because the Partridge-party has no video telephone.

Further, even if the conversion could occur, then the static images of Partridge would disappear. That defeats Partridge's purpose. MPEP § 2143.01, last paragraph, states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

MPEP § 2143.01 states:

THE PROPOSED MODIFICATION CANNOT RENDER THE  
PRIOR ART UNSATISFACTORY FOR ITS INTENDED  
PURPOSE

If proposed modification would render the

09/181,151  
Art Unit 2743  
7833

prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

The MPEP does not allow the modifications of Dagdeviren and Partridge which the Answer is proposing.

Answer, page 15, First Full Paragraph

Appellant pointed out that Morino is contrary to Dagdeviren. The Answer asserts that Morino is cited for a specific proposition, and implies that the contradiction can be ignored.

Appellant points out that references are read **as-a-whole**. MPEP § 2141.03, last paragraph, states:

Prior art must be considered in its entirety, including disclosures that teach away from the claims.

Answer, Page 15, Second Full Paragraph

The Answer states that Morino implicitly shows termination of the images. Appellant points out that this assertion is a naked conclusion, unsupported by evidence.

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

09/181,151  
Art Unit 2743  
7833

determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.  
[Citation.]

This MPEP section has not been followed.

Appellant submits that a fair reading of Morino's Abstract indicates that the static images remain after the conference begins. This is a question of interpretation of the Morino reference.

Answer, Page 15, Last Paragraph

Claim 13 states that a "live video image of the participant previously depicted in the static picture" replaces the still image. If Morino shows this, then where does Morino show a video camera for producing the "live video image" ?

The Answer asserts that the "live video image" is implicit, because a video conference is involved. Appellant submits that this premise is false. Morino's abstract does not discuss a "video conference," but a "conference." That could be an audio conference, or it could be "collaboration," where users communicate via a computer screen, as when users type on a common document.

Further, if Morino's parties are connected by a low-bandwidth connection, it probably would **NOT** be a "live" video conference, because of bandwidth limitations.

Again, the recitation has not been shown in the reference.

09/181,151  
Art Unit 2743  
7833

The discussion regarding claim 12, immediately above, applies to this claim.

Answer, Page 14, First Paragraph

The Answer has still not provided a teaching for combining the references. Whether Dagdeviren, as modified by Partridge, is "enhanced" is not a teaching.

That is, the properties of the combined references, such as "enhancement," are not teachings for making the combination in the first place.

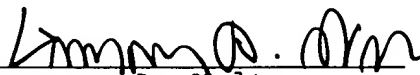


09/181,151  
Art Unit 2743  
7833

**CONCLUSION**

Applicant requests that the Board reverse the rejections of all claims, and pass all claims to issue.

Respectfully submitted,

  
Gregory A. Welte  
Reg. No. 30,434

NCR Corporation  
1700 South Patterson Boulevard  
WHQ - 5  
Dayton, OH 45479  
May 27, 2002

(937) 445 - 7663

WELTE DIRECT: (765) 296 - 4699